

REMARKS

The above-captioned patent application has been carefully reviewed in light of the Official Action to which this Amendment is responsive. Claims 1, 3, 6, 11, 12, 17, 19, 22, 23, 31 and 33 have been amended in an effort to further clarify and to particularly point out the present invention. Claims 5, 13 and 32 have been canceled. To that end, it is believed that no new matter has been added.

Claims 1-24 and 31-33 are pending, Claims 25-30 and 34-36 having been withdrawn due to a Restriction Requirement. Applicants gratefully acknowledge the combination of the Groups I and III for joint examination.

As to the status of the examined claims, Claims 1-4, 6-24 and 31-33 stand rejected based on certain prior art. Claim 13 has also been objected to, based on certain informalities. Applicants respectfully request reconsideration based on the following comments, as well as the amended claims.

Applicants gratefully acknowledge the allowability of Claim 5 over the prior art of record.

Turning to the prior art rejections, Claims 1, 3, 7-9, 11, 14, 16, 20-22, 24, 31 and 32 have been rejected under 35 USC §102(b) as being anticipated by Nussenbaum (U.S. Patent No. 5,542,905). Applicants respectfully traverse this rejection.

In order to successfully anticipate under the Statute, each and every claimed limitation must be found in the single cited prior art reference. These limitations that are not found must be notoriously well known to one of sufficient (i.e., ordinary) skill in the field of the invention.

Nussenbaum describes a laryngoscope that includes a handle and a blade which is pivotally moved between a non-operating position and an operating position. The handle includes a lower base portion and an upper head portion wherein a vertical stack of batteries are provided within the base portion of the handle. Disposed within the head portion of the handle is a lamp assembly that is fitted within a mounting sleeve 21. The mounting sleeve 21 is inset within a collar 23 wherein the lamp contact extends in relation to a plunger 27 disposed in a bore of

a sliding terminal 26 inset within a barrel 25 that is located between the battery terminal and the lamp assembly; see Figs. 2, 3. Movement of the laryngoscope blade, which is pivotally attached to the head section of the handle, causes relative movement in that the blade sleeve 8 is depressed downwardly, causing the mounting sleeve 21 to also move in a downward fashion (e.g., towards the battery) in order to bring the center contact of the lamp into contact with the upper end of the plunger 27 while at the same time the sliding terminal contacts the upper battery terminal to complete the electrical circuit.

Though relative movement is achieved by this instrument, it is the blade, an operating portion of the apparatus, that causes activation/deactivation to occur. There is no selectivity in having the blade in an operative portion without automatically engaging the lamp, except for battery removal. The present instrument, on the other hand, provides a switch mechanism that provides truly selective operation of the instrument. Moreover, the present device is distinguishable in that the operating member of the device overcomes the biasing force placed between the batteries and the contact of the lamp assembly of the instrument by causing axial movement of the at least one retained battery from a first position to a second position, wherein the biasing force permits electrical contact to occur. Nussenbaum, on the other hand, creates a compressive force through action/movement of the blade in order to provide electrical contact.

Claim 1 has now been amended to add the subject matter of Claim 5, deemed allowable by the Examiner, and has further been amended to positively recite that the at least one movable member is engageable with the at least one contained battery for selective movement from a first position in which electrical contact is provided between the electrical contact of the lamp assembly and the at least one battery to a second position in which the biasing force is overcome and a spacing is formed between the electrical contact and the at least one battery. To that end, it is believed the rejection with regard to Claims 1, 3 and 7-9 is now moot and should be withdrawn. Claim 11 has also been amended to include the subject matter of Claim 13, also now canceled, rendering this rejection moot as well as those to Claims 14,

16 20-22 and 24. More specifically, Claim 11 has been amended to positively recite that the light source assembly includes an electrical contact in proximity to the at least one contained battery that is biased into electrical contact with the contact of the light source assembly and in which the switch assembly includes an engagement portion that selectively overcomes the biasing force by moving the at least one battery from a first position to overcome the biasing force and define a spacing in order to permit selective energization of the light source assembly.

Claim 31 has been similarly amended to incorporate the subject matter of canceled Claim 32 and to more clearly and positively recite the biased condition of the at least one retained battery within the instrument and the selective movement of said at least one battery to overcome the biasing force relative to the electrical contact of the lamp assembly in order to create spacing between the at least one battery and the lamp assembly. Because Nussenbaum fails to recite or suggest this form of operation, there can be no anticipation under the Statute. Claims 14, 16, and 20-22 are also believed allowable for the same reasons. Reconsideration is therefore respectfully requested and withdrawal of this rejection is earnestly solicited.

Claims 1-2, 9, 11-12, 14-15, 22-23 and 31-32 have also been rejected under 35 USC §102(b) as being anticipated by Miller (U.S. Patent No. 6,679,616). Applicants respectfully traverse this rejection. As previously noted, each and every claimed limitation must be found in the single cited reference to successfully invoke an anticipation rejection under the Statute.

Miller describes a miniature flashlight used on key chain that is made from an extremely flexible plastic material. The back wall of the flashlight housing, according to this reference, can be squeezed in order to create relative movement of a contained battery relative to a lamp. A flexible housing spacer is provided in order to create a narrowed intermediate portion through which the battery contact is directed in order to respectively engage the lamp contact.

As previously recited and in order to successfully anticipate under the Statute, each and every claimed limitation must be found in the cited reference. Those limitations that are not found must be notoriously well known to one of ordinary skill in the field of the invention.

The lamp assembly of Miller is not biased into contact with the contained battery and like Nussenbaum, an action must be performed to initiate electrical contact so as to energize the flashlight. The present invention, as recited in amended Claims 1, 11 and 31, require the switch assembly to overcome a pre-existing biasing force and cause movement of at least one contained battery relative to an electrical contact of the lamp assembly in order to create spacing between the contained battery and the lamp assembly. As noted above, Claim 1 has now been clarified to include the subject matter of Claim 5, now canceled, which render the rejection moot. In addition, Claim 1 has been further amended to positively recite that the at least one battery is selectively caused to move relative to the electrical contact of the lamp assembly through action of the at least one movable member that is engageable with the at least one battery. In any event and because Miller fails to include or suggest any of these essential features, there can be no anticipation under the Statute. Similarly, Claims 2 and 9 are believed allowable for the same reasons, since these claims depend thereupon. Reconsideration is respectfully requested.

Claim 11 now contains the subject matter of Claim 13. For this reason alone, it is believed the rejections of Claims 11, 12, 14, 15, 22 and 23 are also moot and should be withdrawn. Claim 31 has been amended to positively recite the subject matter of Claim 32 and to more definitely clarify that the method require selective movement of the at least one retained battery out of electrical contact with the lamp assembly by overcoming the biased connection between the electrical contact of the lamp assembly and the at least one battery using a mechanical switch. Since Miller does not operate in the same manner nor contains the same essentially claimed subject matter, there can be no anticipation under the Statute. Reconsideration is therefore respectfully requested.

Claims 1-4, 6, 9-13, 14-19, 22 and 31-33 have been rejected under 35 USC §103(a) as being unpatentable over Shin (U.S. Patent Publication No. 2003/0195391) in view of McRoskey (U.S. Patent No. 3,400,236). Applicants respectfully traverse this rejection.

In order to maintain a successful *prima facie* obviousness rejection under the Statute, each and every essentially claimed component or step must be found, either singly or in combination, in the prior art. Those limitations that are not found must be notoriously well known to one of sufficient (e.g., ordinary) skill in the field of the invention of the time of the invention. Furthermore, there must be a motivation found in the prior art as a whole to combine the references in the manner posited by the Examiner. This motivation cannot be from an impermissible piece-meal combination of features, that is, from advance knowledge, e.g., hindsight, of the invention.

Shin describes a lighting and unlocking instrument that includes a hollow handle to which an instrument head is attached. The handle is sized to accommodate a plurality of stacked batteries and an on-off switch is included at the middle of the handle at the outer surface thereof. The switch, according to the terse description of this publication, is used to turn a contained bulb on, the bulb being used within the instrument head. No description concerning the operation of this on/off switch, however, is provided anywhere in the disclosure of this reference.

McRoskey describes an electric switch that can be used in conjunction with the control of motor or other electric circuits, such as in the connection of toy devices; see col. 1, lines 30-32. The switch assembly, shown in three alternative embodiments, employs a fixed contact as well as a movable contact made movable through a slide member or other movable switch body. As described herein, the switch performs the specific movement wherein the fixed contact can include a battery electrode – see, for example, Fig. 5. To that end, this prior art fails to describe a switch member that has an engagement portion, which when selectively employed, overcomes a biasing force already applied to at least one contained battery to overcome the biasing force and to create spacing between the lamp assembly and

assembly and the contained batteri(es). Moreover, neither of these references either disclose or infer the movement of the at least one contained battery by means of a mechanical switch that overcomes a biasing force so as to create a spacing between the electrical contact and the at least one battery. Because neither Shin nor McRoskey teach, describe or otherwise suggest these essential features, there can be no *prima facie* obviousness rejection of Claim 1, as amended, under the Statute. Claim 11, as amended, is also believed allowable in that none of the cited prior art includes or suggest a biased relation for the batteries within the handle of the diagnostic instrument and a switch member that has an engagement portion for selectively overcoming the biasing force and moving the at least one battery from a first position in order to define a spacing between the at least one battery and the electrical contact of the light source assembly in order to permit selective energization and de-energization of the light source. Claims 12, 14-19 and 22 are believed allowable for the same reasons pertaining to amended Claim 11. As previously noted, Claim 13 has been canceled.

Finally, Claim 31 is also believed to be patentably distinct from the cited references in that neither Shin and/or McRoskey teach, describe or otherwise suggest a method of operating a medical diagnostic instrument that includes the steps of disposing an electrical contact of a lamp assembly into biased electrical connection with at least one retained battery of the instrument, and selectively moving the at least one battery out of electrical contact with the lamp assembly by overcoming the biased connection therebetween using a mechanical switch. Because neither of the references contains or suggests these recited features, either singly or in combination, there can be no *prima facie* obviousness rejection maintained under the Statute. Claim 33 is believed allowable for the same reasons. Reconsideration is therefore respectfully requested.

Because Claim 13 has been canceled, the claim objection related thereto as noted in the outstanding Office Action is believed to be moot. Claim 11, as amended, now incorporating Claim 13 is believed to be written to overcome this objection. Applicants have amended Claims 3, 6, 12, 17, 19, 22 and 23 to comport



Serial No.: 10/613,679
Amendment Dated: September 7, 2005
Reply to Office Action of June 16, 2005

to the language of amended Claims 1 and 11. To that end, no new matter has been added. Finally, Claims 19 and 33 have been amended to change their dependency, the latter due to the cancellation of Claim 32 and incorporation thereof into amended Claim 31. It is believed the claims are now in an allowable condition.

In summary, it is believed the above-captioned patent application is now in allowable condition and such allowance is earnestly solicited.

If the Examiner wishes to expedite disposition of the above-captioned patent application, he is invited to contact Applicants' representative at the telephone number below.

The Director is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

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